SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

No. 257, 258, 259

MINNESOTA MINING & MANUFACTURING COMPANY,

Petitioner,

against

CONWAY P. COE, COMMISSIONER OF PATENTS,

Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRITS OF CERTIORARI.

The Opinion of the Court Below.

The opinion of the Court of Appeals for the District of Columbia is reported at 118 F. (2d) 593, and appears in the record filed herewith (R. 307 to 310).

Two opinions were entered by the trial court, one covering the two Oakes cases (R. 79-85) and the other covering the Bartling case (R. 278-80). The trial court also prepared joint Findings of Fact and Conclusions of Law in the two Oakes cases (R. 85-90), and separate Findings in the Bartling case (R. 280-81).

Jurisdiction.

The grounds on which the jurisdiction of this Court is invoked have been set forth in the Petition.

Attention, however, is called to two other cases where this Court took jurisdiction in suits against the Commissioner of Patents under Revised Statutes, § 4915:

Butterworth, Commissioner of Patents, v. *Hill, et al.,* 114 U. S. 128;

Gandy v. *Marble, Commissioner of Patents,* 112 U. S. 432.

Statement of the Case.

The facts are sufficiently stated in the Petition.

Specification of Errors.

The errors which Petitioner will urge, if the Writs of Certiorari are issued, are that the Court of Appeals failed to answer the questions set out in the Petition hereof in the affirmative and rendered judgments contrary to an affirmative answer to said questions, or any of them.

Summary of Argument.

The summary of argument and also the arguments themselves, relied upon for the issuance of the Writs of Certiorari, are primarily set forth in the foregoing Petition (*supra,* pp. 8-18). Only brief additional arguments follow.

Argument.

It is, of course, well settled that every novel and useful thing does not necessarily involve patentable invention. But it is equally well settled, as pointed out in the Petition, *supra,* that where an article of manufacture defined in an application for letters patent is new and useful, and doubt exists as to its "inventiveness" or "patentability", such

doubt should be resolved in favor of issuing the patent. Doubts are raised by facts or circumstances, established by the record, showing that the new and useful thing measures up to standards of invention which have been enunciated and followed by authoritative tribunals. Advantages and improvements due to the novel construction are among the most important indicia of invention. Also, rulings in parallel cases, as the holding of patentability as to the claims of Robie, Paulson and Hepp by issuance of patents to them, is another and important standard of invention because it shows what the Patent Office, as the expert administrative agency, regarded as indicating attainment sufficient to involve patentable invention.

If reasonable doubts were not to be resolved in favor of an appellant in an appeal of this kind, then the appeal could not be efficacious no matter how well appellant's evidence showed that his novel and useful article measured up to the established standards of invention; because, how could the Court of Appeals ever decide that the issues should be decided in appellant's favor as a matter free of doubt when the trial court had held against plaintiff? For the Court of Appeals to so decide would be for that court to conclude that the trial judge lacked rationality and was wrong beyond doubt in deciding that "invention" was lacking. But how could any appellate court reach such a conclusion where the question which the trial court decided was the difficult question of "invention", the proper determination of which is dependent on the proper application of complex rules of law?

As stated in the petition, the above indicia of invention, in addition to novelty and utility, have been clearly demonstrated (R. 307-310). The fact that doubts exist on the question of patentable invention is recognized by the majority of the Court of Appeals (two judges) and is confirmed and emphasized by the dissent on the merits by one judge.

When a patent issues, whether it issues as the result of a suit under section 4915 R. S., or otherwise, it, of course, is only presumed *prima facie* to be valid and to involve patentable invention; it is not conclusively presumed to be valid. The basic, underlying reason for resolving reasonable doubts in favor of invention in applications for patents, including suits under section 4915 and appeals of all types, is so that a patent may expeditiously issue, leaving doubtful questions of validity or "patentable invention" (where they exist) to be determined subsequently in an *inter partes* suit. To deny a patent in such cases would be to deprive the inventor of the opportunity ever to have a full determination of his rights in an ordinary infringement suit.

The majority of the Court of Appeals is here confusing principles of law. If the rule of *resolving reasonable doubts* in favor of the applicant applies to the District Court in a suit of this nature (and this principle is admitted by appellee-respondent and shown by various decisions, with no decision to the contrary), then the Court of Appeals must consider this rule and determine whether the same has been correctly applied by the District Court. The Court of Appeals must determine and decide whether the proper rules, standards and presumptions of the law have been correctly applied; otherwise violations of or departures from settled principles of law by the trial court will neither be detected nor corrected by the Court of Appeals, D. C.

Thus the reasonable doubt rule is one which the Court of Appeals must consider and apply in cases of this character, in order fully to review whether the District Court followed the law. For the Court of Appeals to say that the rule of resolving reasonable doubts in favor of the applicant does not apply in "appeals from the District Court" (R. 309) in suits under section 4915 R. S. to obtain a patent, is as anomalous and as opposed to established rules of

law and settled principles of appellate review as it would be for an appellate court to hold that the doctrine of presumed innocence in criminal cases does not apply in "appeals from the trial court". That the latter ruling would be unsound needs no citation of authority; but, on this point, see this Court's decision in *Patterson* v. *Alabama*, *supra*.

Also such a principle in regard to appellate review is opposed to the ruling of the First Circuit, as affirmed by this Court in *Powers* v. *Commissioner of Internal Revenue* 312 U. S. 259; 61 Sup. Ct. 509; 85 L. Ed. 435 (1941). There the First Circuit reversed the U. S. Board of Tax Appeals on the ground that it had applied a wrong standard in determining the "value" of certain insurance policies. "Value" is of course a question of fact. In affirming the First Circuit this Court stated (85 L. Ed. 435, 436):

> "That judgment must be affirmed * * *, unless as claimed by petitioner the court below was precluded from substituting its judgment *of value* for that of the Board. * * * But the question of what *criterion* should be employed for determining the 'value' of the gifts is a question of law. See Lucas *v.* Alexander, 279 U. S. 573, 73 L. Ed. 851, * * * Accordingly, the Circuit Court of Appeals was justified in reversing the decision of the Board as 'not in accordance with law'." (Emphasis added.)

Similarly, this Court should take jurisdiction and, applying the above doctrine to appellate review under section 4915 R. S., and following the view of the dissenting justice in the instant causes, put at rest the analogous proposition that "what criterion should be employed in determining" *invention* in a novel and decidedly useful article "is a question of law".

The nature of the question of "invention" has been investigated and discussed by this Court. In *McClain* v. *Ort-*

mayer, 141 U. S. 419, 427, 35 L. Ed. 800, at 803 (1891) this Court stated:

> "The truth is the word cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not * * * Courts, *adopting fixed principles as a guide*, have by a process of exclusion determined that certain variations in old devices do or do not involve invention; * * *" (Emphasis added.)

The nature of the question of "invention" has more recently been discussed in *Cleveland Trust Co.* v. *Schriber-Schroth Co.*, 92 F. (2d) 330, at 334 (1937) where the Circuit Court of Appeals, 6th Cir., stated:

> "Probably the most difficult task that confronts a patent court lies in determining whether there is invention", etc.

Note that it is an appellate court which is here concerned with the question of "invention".

Conclusions.

It is a novel and anomalous departure in our law, fraught with much confusion and mischief, for the Court of Appeals, D. C., to affirm the trial court without determining and deciding whether the trial court has correctly applied established standards and presumptions of the law in arriving at its implied conclusion of "no invention", thereby casting a cloud on the validity of claims of issued patents, and claims forming counts of Interferences presently pending in the Patent Office, in a suit in which none of the patentees or their assignees is a party. (Actually the trial court made no express finding of fact that "invention" is lacking, or, as it is sometimes stated, that the requisite "unobviousness" is lacking, or any equivalent express finding of fact.)

For the reasons herein stated it is believed that this Court should be moved to grant Writs of Certiorari, (for reasons generally comparable to those that moved it to do so in *Powers* v. *Commissioner of Internal Revenue, supra,* even where, as distinguished from the present causes, there was no dissent in the First Circuit), to the end that the scope of appellate review under section 4915 R. S. will be clarified and settled and the fundamental questions of patent law hereinabove presented may be settled by this Court and the judgments of the court below reversed.

Respectfully submitted,

PAUL CARPENTER,
HAROLD J. KINNEY,
Attorneys for Petitioner.

July 9, 1941.